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A-3

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/309,396    05/07/99    SMITH    M    YC1.P07

CHRIS E SVENDSEN  
STRATTON BALLEW PLLC  
213 SOUTH 12TH AVENUE  
YAKIMA WA 98902

IM62/1228

EXAMINER

SHERRER, C

ART UNIT

PAPER NUMBER

1761

8

DATE MAILED:

12/28/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trad marks**

# Office Action Summary

Application No.

09/309,396

Applicant(s)

Smith et al

Examiner

Curtis E. Sherr r

Group Art Unit

1761



☒ Responsive to communication(s) filed on Oct 2, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-19 is/are pending in the application

Of the above, claim(s) 3-11 is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1, 2, and 12-19 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### Part III DETAILED ACTION

#### *Drawings*

1. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

#### *Double Patenting*

2. Claims 16-19 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 13-15. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

#### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2 and 12-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laws et al (U.S. Pat. No. 4,212,895) or Law et al (U.S. Pat. No. 4,218,491) for the reasons set forth in the last Office Action. See comments below.

***Response to Arguments***

5. Applicants' arguments filed 10/02/00 have been fully considered but they are not persuasive.

6. Applicants argue that the process of '895 patent leaves a residual of over 1% organic solvent in the produced extract and this process would not be combinable with the process of the '491 patent. The Examiner's rejection does not combine the processes. Further, the claims are directed to products and there is no exclusion of solvents. Nor has Applicants shown what amounts of solvent would actually be contained in the prior art extracts.

7. Applicants assert a "key and unforeseen feature" of the claimed invention "is the stability" of the product. It is not clear if Applicants are asserting unexpected results to overcome the *prima facie* case of obviousness. If so, evidence needs to be submitted in the form of data, rather than mere opinion.

8. Applicants state that the "brewmaster's conventional wisdom teaches away from premixing extract products." Basis for such a statement was not given and it is not found

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accurate. In fact, Applicants have admitted, in their Background of the Invention, that those in the brewing arts commonly mix various fractions of hops (page 2, lines 16-19 and lines 26-28).

9. Applicants find the citation to *In re Levin* to be dubious based on its lack of citation in current case law. While no published evidence of its application is available, the Examiner, and Art Unit 1761, consistently cite this case to the Board of Patent Interferences and Appeals. *Levin's* holding has never been overturned or discounted and it is therefore considered to be good law.

***Conclusion***

10. No claim is allowed.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Curtis Sherrer whose telephone number is (703) 308-3847. The examiner can normally be reached on Tuesday through Friday from 6:30 to 4:30. The **fax phone number** for this Group is (703)-305-3602.

13. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

A handwritten signature in black ink, appearing to read 'Curtis E. Sherrer', with a long horizontal flourish extending to the right.

Curtis E. Sherrer  
Primary Examiner  
December 28, 2000